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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,309	02/20/2004	Sven-Borje Andersson	PC 27198A	7824

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EXAMINER	
FELTON, MICHAEL J	
ART UNIT	PAPER NUMBER
1731	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/19/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/783,309	ANDERSSON ET AL.	
	Examiner	Art Unit	
	Michael J. Felton	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8 and 11-17* is/are pending in the application.

4a) Of the above claim(s) *9, 10, 18-26* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8 and 11-17* is/are rejected.

7)☒ Claim(s) *1* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of claims 1-8, and 11-17 in the reply filed on 10/12/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Objections

2. Claim 1 is objected to because of the following informalities: "releasable" is being use as an adverb and should be replaced with "releasably". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims, 2, 3, 4, 8, and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claims 2, 3, and 4, specific gas flow resistances of the shaped mass of fibers or filaments are disclosed. The specification discloses the same resistances as well as the motivation for them, but no means for achieving the desired flow resistance is disclosed. Therefore, these claims are not enabled, as one of ordinary skill in the art at the time of invention would not know how this invention was being enabled.

Claim 8 discloses that the container comprises sintered material, but there is no mention of sintered material in the specification, only non-sintered materials are disclosed. Therefore this claim is not enabled.

Claim 17 discloses that the retaining AND/OR releasing of nicotine in the container is enhanced by electricity and/or temperature. The specification repeats a statement similar to the claim, but provides no information on how electricity or temperature is applied in the invention. In addition, the statement in the specification does not indicate that nicotine is retained using electricity or temperature. For the above reasons, this claim is not enabled.

In each of the above situations, the specification is not enabling and meets the factors set forth in In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998)(See also MPEP § 2164.01(a) and § 2164.04). Claims 8 and 17 are broad, while claims 2, 3, and 4, are somewhat narrower. This invention is an improvement on the prior art, however the prior art was deeply flawed. US 6089632 to Turner et al., indicates that a prior invention in this narrow field failed. "However, it was unexpectedly found that the nicotine free based migrated through the packaging material and rapidly disappeared from the system...the shelf-life of the unrefrigerated vapor inhaler was

approximately one month," says Turner et al. (Col. 2, 1-6). The sparse prior art shows evidence of failures and unpredictability. Although one example is provided in the instant application, its flow rates, the inclusion of sintered material, and use of electrical or temperature to facilitate nicotine release or attachment are not included in the example. Therefore, for the above reasons, in addition to the lack of direction in the specification and the amount of experimentation needed, these claims are not enabled.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5, 6, 7, 11, 12, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by 4,800,903 to Ray et al.

Ray et al. disclose a preferred embodiment of a shaped mass of polyethylene filaments that releasably absorbs nicotine (instant application claims 1, 5, 11, 12, 13, and 14; Ray et al., Col 5, line 52-60). They also disclose using a film (non-fibrous) to wrap the filaments (instant application claim 6; Ray et al., Col. 13, table 12). Ray does not disclose that any sintering of the filaments is undertaken (instant application claim 7).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over 4,800,903 to Ray et al. Although Ray et al., disclose the above features (see 102 rejection), they do not disclose production of fibers or filaments by spinning and or

extrusion. However, Ray et al., indicate that the plug containing nicotine, "may be produced mechanically and may also be a mass of filaments," (Col 5, line 52-60). It is notoriously well known to make fibers by spinning, extrusion or other methods. The instant application acknowledges the prior art by saying, "The fiber or filaments may be manufactured in a number of different ways known in the art, such as through extrusion and spinning," (paragraph 0039). It would have been obvious to one of ordinary skill in the art at the time of invention to use spinning and/or extrusion to make the fibers or filaments used in the invention.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over 4,800,903 to Ray et al. in view of 2,818,868 to Rivers, Jr. Although Ray et al. disclose using polyethylene terephthalate (PET) film for enclosing the fiber with absorbed nicotine, using PET as a fiber or filament is not disclosed. However, Rivers, Jr. discloses that PET can be used as a fiber in cigarette filters. In this similar application nicotine is retained and released by the filter during combustion of the tobacco. It would have been obvious to one of ordinary skill in the art at the time of invention to use PET and other fibers use in cigarette filters in the present invention.

6. Claims 2, 3, and 4, are rejected under 35 U.S.C. 103(a) as being unpatentable over 4,800,903 to Ray et al. in view of memorandum, "Prediction of Tar Yields From Measurements of Cigarette Pressure Drop and/or Filter Ventilation," by Calleson, D.A. (published 27 Feb 1998). Ray et al. disclose the invention in claim 1, but do not indicate the flow rates of the container they disclose. However, Calleson discloses that many factors control the pressure drop (flow restriction) over a cigarette and that this is not

dependent on the materials used, but instead on the design of the device. The mass of fibers or filaments in the present invention could be used as part of a cigarette, and in doing so, different pressure drops would be desired. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to create fiber or filament masses with different pressure drops.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Felton whose telephone number is 571-272-4805. The examiner can normally be reached on Monday to Friday, 7:30 AM to 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJF

ERIC HUG
PRIMARY EXAMINER